

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
OAKLAND DIVISION**

TECHNOLOGY PROPERTIES LIMITED	)	Case Number: C 14-03641-CW
LLC and MCM Portfolio LLC,	)	
	)	<b>JOINT CASE MANAGEMENT</b>
Plaintiffs,	)	<b>STATEMENT &amp; [PROPOSED] ORDER</b>
	)	
vs.	)	Date: November 19, 2014
	)	Time: 2:00 pm
FALCON COMPUTER SYSTEMS, INC.,	)	Ctrm: 2, 4 <sup>th</sup> Floor
	)	
Defendant(s).	)	Hon. Judge Claudia Wilken

TECHNOLOGY PROPERTIES LIMITED	)	Case Number: C 14-03642-CW
LLC and MCM Portfolio LLC,	)	
	)	<b>JOINT CASE MANAGEMENT</b>
Plaintiffs,	)	<b>STATEMENT &amp; [PROPOSED] ORDER</b>
	)	
vs.	)	Date: November 19, 2014
	)	Time: 2:00 pm
HITI DIGITAL AMERICA INC.,	)	Ctrm: 2, 4 <sup>th</sup> Floor
	)	
Defendant(s).	)	Hon. Judge Claudia Wilken

1	TECHNOLOGY PROPERTIES LIMITED	)	Case Number: C 14-03643-CW
2	LLC,	)	
3	Plaintiffs,	)	<b>JOINT CASE MANAGEMENT</b>
4	vs.	)	<b>STATEMENT &amp; [PROPOSED] ORDER</b>
5	HEWLETT-PACKARD COMPANY,	)	Date: November 19, 2014
6	Defendant(s).	)	Time: 2:00 pm
7		)	Ctrm: 2, 4 <sup>th</sup> Floor
8	TECHNOLOGY PROPERTIES LIMITED	)	Hon. Judge Claudia Wilken
9	LLC and MCM Portfolio LLC,	)	
10	Plaintiffs,	)	Case Number: C 14-03644-CW
11	vs.	)	<b>JOINT CASE MANAGEMENT</b>
12	KINGSTON TECHNOLOGY CO., INC.,	)	<b>STATEMENT &amp; [PROPOSED] ORDER</b>
13	Defendant(s).	)	Date: November 19, 2014
14		)	Time: 2:00 pm
15	TECHNOLOGY PROPERTIES LIMITED	)	Ctrm: 2, 4 <sup>th</sup> Floor
16	LLC and MCM Portfolio LLC,	)	Hon. Judge Claudia Wilken
17	Plaintiffs,	)	
18	vs.	)	Case Number: C 14-03645-CW
19	NEWEGG INC., et al.,	)	<b>JOINT CASE MANAGEMENT</b>
20	Defendant(s).	)	<b>STATEMENT &amp; [PROPOSED] ORDER</b>
21		)	Date: November 19, 2014
22	TECHNOLOGY PROPERTIES LIMITED	)	Time: 2:00 pm
23	LLC and MCM Portfolio LLC,	)	Ctrm: 2, 4 <sup>th</sup> Floor
24	Plaintiffs,	)	Hon. Judge Claudia Wilken
25	vs.	)	
26	SEIKO EPSON CORPORATION, et al.,	)	Case Number: C 14-03646-CW
27	Defendant(s).	)	<b>JOINT CASE MANAGEMENT</b>
28		)	<b>STATEMENT &amp; [PROPOSED] ORDER</b>

1	TECHNOLOGY PROPERTIES LIMITED	)	Case Number: C 14-03647-CW
2	LLC and MCM Portfolio LLC,	)	
3	Plaintiffs,	)	<b>JOINT CASE MANAGEMENT</b>
4	vs.	)	<b>STATEMENT &amp; [PROPOSED] ORDER</b>
5	SHUTTLE COMPUTER GROUP INC.,	)	Date: November 19, 2014
6	Defendant(s).	)	Time: 2:00 pm
		)	Ctrm: 2, 4 <sup>th</sup> Floor
		)	Hon. Judge Claudia Wilken

Pursuant to Civil L.R. 16-9 and the Court’s Standing Order regarding case management conferences, Plaintiffs Technology Properties Limited LLC and MCM Portfolio LLC (collectively “Plaintiffs”) and Defendants Canon Inc., Canon U.S.A., Inc., Falcon Northwest Computer Systems, Inc., HiTi Digital America Inc., Hewlett-Packard Company, Kingston Technology Company, Inc., Newegg Inc., Rosewill Inc., Seiko Epson Corporation, Epson America, Inc. and Shuttle Computer Group Inc. (collectively “Defendants”) (together, “the parties”) jointly file this Joint Case Management Statement in the above-captioned, related cases.

**1. Jurisdiction & Service**

The Court has subject matter jurisdiction over Plaintiffs’ claims pursuant to 28 U.S.C. §§ 1331 and 1338(a). Defendants Hewlett-Packard Company and Defendant Newegg Inc. contend that this Court has subject matter jurisdiction over their counterclaims pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202. No issues exist regarding personal jurisdiction or venue. Plaintiffs assert that all parties have been served; Defendant HiTi Digital America, Inc. and Shuttle Computer Group Inc. dispute this assertion, but have waived their rights to file a pre-answer motion under Fed. R. Civ. P. 12(b).

1       **2.     Facts**

2               **A.     Brief Chronology of The Facts**

3               Plaintiff Technology Properties Limited LLC (“TPL”) originally filed these actions  
4 against Defendants on March 28, 2012 in the United States District Court for the Eastern District  
5 of Texas (“Texas Action”), alleging, *inter alia*, that Defendants infringed one or more of U.S.  
6 Patent Nos. 7,522,424 (“the ’424 patent”), 7,295,443 (“the ’443 patent”), 7,719,847 (“the ’847  
7 patent”), and 7,162,549 (“the ’549 patent”) (together, “the Asserted Patents”)<sup>1</sup> by importing,  
8 making, using, offering to sell, and /or selling certain products. Plaintiff MCM alleges that it is  
9 the owner of the Asserted Patents, and Plaintiff TPL alleges that it is the exclusive licensee of the  
10 Asserted Patents, with the ownership of all substantial rights in the patents, including the right to  
11 exclude others and to enforce, sue, and recover damages for past and future infringement.  
12

13  
14               On March 27, 2012, Plaintiff TPL filed a Complaint with the United States International  
15 Trade Commission requesting that the ITC commence an investigation under Section 337 of the  
16 Tariff Act of 1930, as amended, 19 U.S.C. § 1337, to remedy the allegedly unlawful importation  
17 into the United States, the sale for importation, and/or sale within the United States after  
18 importation, by manufacturers, importers, or consignees (or any agent of the owner, importer, or  
19 consignee) of certain computers and computer peripheral devices and components thereof and  
20 products containing the same that allegedly infringe, *inter alia*, one or more the ’443, ’424, ’847,  
21 and ’549 patents. Defendants and/or their parent companies were named as Respondents in the  
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 <sup>1</sup> While other patents were originally asserted in some of the Texas Actions and in the ITC investigation, Plaintiffs  
27 amended complaints allege infringement of only the ’443, ’424, and ’847 patents.

1 ITC Complaint, in addition to other non-party entities that subsequently entered into settlement  
2 agreements with Plaintiff.<sup>2</sup>

3 On April 27, 2012, the ITC issued a Notice of Institution of Investigation to determine  
4 whether there was a violation of Section 337 by Respondents, including Defendants. The  
5 investigation was captioned as *In the Matter of Certain Computers and Computer Peripheral*  
6 *Devices and Components Thereof and Products Containing The Same*, Inv. No. 337-TA-841 and  
7 assigned to Administrative Law Judge Theodore Essex.  
8

9 The District Court for the Eastern District of Texas subsequently stayed the Texas  
10 Actions on May 22, 2012 pending resolution of Investigation No. 337-TA-841.

11 On August 2, 2013, after extensive fact and expert discovery and a four-day evidentiary  
12 hearing, Judge Essex issued an Initial Determination finding that each of the '443, '424, '847 or  
13 '549 patents is not invalid and finding that none of those patents was infringed by any party to  
14 the ITC proceeding. On December 19, 2013, the ITC issued a Final Determination affirming  
15 Judge Essex's findings.  
16

17 Plaintiff moved to lift the stay of the Texas Actions on February 7, 2014. On February  
18 10, 2014, the District Court for the Eastern District of Texas granted Plaintiff's motion to lift the  
19 stay.  
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25 <sup>2</sup> HiTi Digital America Inc., Epson America, Inc., Canon U.S.A., Inc., and Shuttle Computer Group Inc. were not  
26 Respondents in the ITC proceeding. HiTi Digital America Inc.'s, Epson America, Inc.'s, Canon U.S.A., Inc.'s, and  
27 Shuttle Computer Group Inc.'s respective parent companies were Respondents. Defendants Falcon Computer  
28 Systems, Inc. and Shuttle Computer Group Inc.'s parent were dismissed early in the ITC proceeding.

1 In April 2014, MCM Portfolio LLC was added as a Plaintiff in an amended complaint in  
 2 the lead Texas Action. Plaintiffs contend that MCM Portfolio LLC is the owner of the Asserted  
 3 Patents.

4 On February 26, 2014, Defendants moved to transfer these cases pursuant to 28 U.S.C. §  
 5 1404(a) to the United States District Court for the Northern District of California. The court  
 6 granted Defendants' motion on July 15, 2014, and these cases were transferred to the Northern  
 7 District of California on August 8, 2014.

8 On October 21, 2014, the above-captioned cases were related before the Honorable  
 9 Claudia Wilken.

#### 10 **B. Statement of the Principal Factual Issues in Dispute**

11 The principal factual issues in dispute are (i) whether Defendants infringe the asserted  
 12 claims of the '443, '424, '847 and/or '549 patents and (ii) whether the asserted claims of the '443,  
 13 '424, and/or '847 patents are invalid or unenforceable.<sup>3</sup> The asserted claims of the '443 patent  
 14 are claims 1, 3, 4, 7, 9, 11, 12, and 14.<sup>4</sup> The asserted claims of the '424 patent are claims 25, 26,  
 15 28, and 29. The asserted claims of the '847 patent are claims 1, 2, and 3. The (previously)  
 16 asserted claims of the '549 patent that are the subject of Hewlett-Packard Company's declaratory  
 17 judgment counterclaim are claims 7, 11, 19, and 21.

#### 18 **3. Legal Issues**

##### 19 **Plaintiffs' Statement:**

20 <sup>3</sup> The '443 and '424 patents are asserted against each Defendant. The '847 patent is asserted against Defendants  
 21 Shuttle Computer Group, Inc. and Hewlett-Packard Company.

22 <sup>4</sup> The set of '443 patent claims asserted against each Defendant varies among the Defendants.

1 The key legal issues include the following subjects:

2 a. Construction of the “mapping” elements of the asserted claims of the Asserted  
3 Patents. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (the first  
4 step in an infringement analysis “is deterring the meaning and scope of the patent claims asserted  
5 to be infringed.”)

6 b. Plaintiffs’ allegations that the accused products meet the “mapping” elements and  
7 infringe the asserted claims of the Asserted Patents, rendering Defendants liable for patent  
8 infringement under 35 U.S.C. § 271.

9 c. Defendants’ allegations that the asserted claims of the Asserted Patents are  
10 invalid.  
11

12 d. Appropriate forms of relief, including declaratory relief, monetary relief,  
13 injunction relief, interest, attorneys’ fees and costs.  
14

15 **Defendants’ Statement:**

16 The key legal issues in this case include the construction of various terms of the asserted  
17 claims in this case, and a determination as to whether those claims are infringed, invalid and/or  
18 unenforceable. While the construction of the “mapping” elements of the asserted claims is an  
19 important legal issue in this case, other elements of the asserted claims also require construction,  
20 and Defendants have non-infringement arguments based upon the “mapping” limitations and  
21 other limitations of the asserted claims. Accordingly, construction of the “mapping” elements –  
22 while dispositive of non-infringement if construed in favor of Defendants – will not be  
23 dispositive of the issue of infringement if construed in favor of Plaintiffs.  
24  
25  
26  
27  
28

Plaintiffs anticipate filing a motion to dismiss Hewlett-Packard's counterclaim for non-infringement of the '549 patent due to lack of a case or controversy. Plaintiffs anticipate filing a motion to dismiss Newegg's counterclaims for non-infringement and invalidity of the '549 patent due to lack of a case or controversy. The parties do not currently anticipate any other motions prior to summary judgment motions.

## **5. Amendment of Pleadings**

The parties do not contemplate any amendments to the pleadings at this time. However, as noted in the immediately preceding section, neither HiTi Digital America, Inc. nor Shuttle Computer Group Inc. has yet answered the complaint or filed counterclaims in view of the pending motion to dismiss. Both anticipate answering and potentially counterclaiming if the motion is not granted.



1       **6.     Evidence Preservation**

2             The parties have reviewed the Guidelines Relating to the Discovery of Electronically  
3     Stored Information. The parties have met and conferred pursuant to Fed. R. Civ. P. 26(f)  
4     regarding reasonable and proportionate steps taken to preserve evidence relevant to the issues  
5     reasonably evident in this action.

6       **7.     Disclosures**

7             **Plaintiffs' Statement:**

8             The parties exchanged initial disclosures pursuant to Fed. R. Civ. P. 26(a) on May 29,  
9     2014 while the above-captioned matters were pending in the United States District Court for the  
10    Eastern District of Texas. Plaintiffs again served initial disclosures on November 12, 2014.

11            Plaintiffs have complied with the requirements of Fed. R. Civ. P. 26(a). Plaintiffs'  
12    disclosures included the following:

- 13            a.     the correct names of the parties to the lawsuit;
- 14            b.     Plaintiffs' statement that to the best of their knowledge, there are no potential  
15               parties to add at this time;
- 16            c.     brief descriptions of Plaintiffs' legal theories and factual basis for their claims  
17               based upon information available to Plaintiffs at the time;
- 18            d.     a list of individuals that Plaintiffs believed may have knowledge of relevant facts  
19               that Plaintiffs may use to support their claims and defenses;
- 20            e.     a statement that Plaintiffs are unaware of any indemnity or insurance agreements  
21               relevant to these actions;
- 22               relevant to these actions;
- 23               relevant to these actions;
- 24               relevant to these actions;
- 25               relevant to these actions;
- 26               relevant to these actions;
- 27               relevant to these actions;
- 28               relevant to these actions;

- 1 f. identification of settlement agreements related to the subject matter of these  
2 actions;  
3 g. a statement that Plaintiff has disclosed all documents believed to be relevant at the  
4 time; and  
5 h. a description of categories of damages claimed by Plaintiffs.  
6

7 In addition, subject to its objections, Plaintiff TPL produced over four thousand (4000)  
8 documents in its possession, custody, or control. Plaintiffs are not currently aware of any other  
9 documents in their possession, custody, or control that are believed to be relevant at this time.  
10 After the termination of the ITC proceeding and prior to May 29, 2014, the parties agreed that re-  
11 production of documents produced in the ITC proceeding was unnecessary given that counsel for  
12 all parties was already in possession of all such documents.  
13

14 **Defendants' Statement:**

15 Defendants contend that the exchange of disclosures in another court does not alleviate  
16 the requirement for the Parties to comply with the Local Rules of this Court. Accordingly,  
17 Defendants anticipate serving Initial Disclosures on November 12, 2014 pursuant to the Federal  
18 Rules of Civil Procedure and this Court's Local Rules.  
19

20 **Discovery**

21 ***Discovery taken to date***

22 **Plaintiffs' Statement:**

23 In the district court actions, before these cases were transferred to the Northern District of  
24 California, the parties exchanged initial disclosures, Plaintiffs served preliminary infringement  
25 contentions, and Defendants served invalidity contentions.  
26

The parties also produced numerous documents,<sup>5</sup> responded to numerous interrogatories and requests for admissions, and took numerous depositions in the ITC proceeding.

**Defendants' Statement:**

Defendants contend that the exchange of certain disclosures and contentions pursuant to the Local Rules of the Eastern District of Texas does not eliminate the need to comply with the Local Patent Rules of this Court. Moreover, the infringement contentions served by Plaintiffs in the Eastern District of Texas are insufficient, particularly in view of the standards governing infringement contentions under the Local Patent Rules for the Northern District of California.<sup>6</sup> Accordingly, the parties should proceed with service of infringement and invalidity contentions as required by the Local Patent Rules of this Court.

**a. The scope of anticipated discovery**

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<sup>5</sup> HiTi Digital America Inc. and Shuttle Computer Group Inc. were not Respondents in the ITC proceeding. Rather, HiTi Digital America Inc.'s parent company was a Respondent; Shuttle Computer Group Inc.'s parent company was also a Respondent. Plaintiff asserts that HiTi Digital America Inc.'s counsel is, however, in possession of all discovery from ITC proceeding; HiTi Digital America Inc. responds that its counsel has requested clarification of which discovery it is expected to possess, but Plaintiffs have not yet identified the scope. Accordingly, because HiTi Digital America Inc.'s counsel does not appear to have received all relevant productions and/or written discovery and Plaintiffs have not clarified what it expects that HiTi Digital America, Inc. possesses, HiTi Digital America Inc. disputes that its counsel possesses all such discovery. Defendants Falcon Computer Systems, Inc. and Shuttle Inc. were dismissed early in the ITC proceeding. Plaintiff asserts that Falcon's and Shuttle's counsel also are in possession of all discovery from the ITC proceeding; Shuttle Computer Group Inc. responds that its counsel has requested clarification of which discovery it is expected to possess, but Plaintiffs have not yet identified the scope. Accordingly, because Shuttle Computer Group Inc.'s counsel does not appear to have received all relevant productions and/or written discovery and Plaintiffs have not clarified what it expects that Shuttle Computer Group Inc. possesses, Shuttle Computer Group Inc. disputes that its counsel possesses all such discovery.

<sup>6</sup> Certain of the Defendants, including Canon Inc., Canon U.S.A., Inc., Seiko Epson Corp., Epson America, Inc., and Kingston Technology Co., Inc. informed Plaintiffs that their initial infringement contentions were insufficient under the Local Rules of the Eastern District of Texas. Certain other defendants, e.g., HiTi Digital America Inc. and Shuttle Computer Group Inc., did not inform Plaintiffs of such insufficiencies due to differing standards of interpretation of the Local Rules in the Eastern District of Texas as opposed to this Court. To the extent that Plaintiffs intend to simply rely on or re-serve the contentions provided previously in the Eastern District of Texas, Defendants intend to challenge those contentions as insufficient under N.D. Cal. Local Patent Rule 3-1.

The parties anticipate discovery on claims in the Plaintiffs' complaints and defenses and counterclaims in Defendants' answers and counterclaims. However, the parties acknowledge that discovery was exchanged and depositions were taken in the ITC proceeding, at least some of which is in the possession of the parties and/or the parties' counsel.<sup>7</sup>

**Plaintiffs' Statement:**

Notwithstanding, Plaintiffs anticipate that additional discovery is needed on products that that were specifically accused in the ITC proceedings where Defendants had not provided sufficient discovery related to the design, functionality, and technical operation thereof.

Plaintiffs also anticipate additional discovery on products accused in this case, and reasonably similar products, that were not specifically accused by name in the ITC proceedings. In addition, because Plaintiff TPL was not seeking damages in the ITC proceeding, discovery relevant to damages will be needed.

**Defendants' Statement:**

Defendants anticipate that additional discovery also is needed regarding other issues, including the prior art, the invention date of the Asserted Patents, the prosecution of the Asserted Patents, and Plaintiffs' and their predecessors' licenses and licensing program.

**b. Proposed limitations or modifications of the discovery rules**

The parties agree as follows:

(i) **Method of Service:** The parties agree to serve documents by email in lieu of personal service or service by U.S. Mail.

(ii) **Disclosure of Discovery of Electronically Stored Information:**

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<sup>7</sup> See *supra*, footnote 5.

a. **General Document Image Format.** The parties agree to produce non-source code documents in single-page, Tagged Image File Format (“TIFF”). TIFF files shall be single page and shall be named with a unique production number followed by the appropriate file extension. Load files shall be provided to indicate the location and unitization of the TIFF files. If a document is more than one page, the unitization of the document and any attachments and/or affixed notes shall be maintained as they existed in the original document.<sup>8</sup>

**b. Native Files.** A party that receives a document produced in a format specified above may make a reasonable request to receive the document in its native format, and upon receipt of such a request, the producing party shall produce the document in its native format.

(iii) **Claims of Privilege:** The parties agree that attorney-client privileged documents and work product documents (including electronically stored information) created after March 28, 2012 do not need to be logged.

(iv) **Protective Order:** The parties will meet and confer on a proposed Stipulated Protective Order to submit for the Court's approval.

**c. Brief report on whether the parties have considered entering into a stipulated e-discovery order, a proposed discovery plan pursuant to Fed. R. Civ. P. 26(f), Any discovery disputes**

The parties intend to work together to enter into a stipulated e-discovery order and a proposed discovery plan pursuant Fed. R. Civ. P. 26(f).

<sup>8</sup> The parties disagree about whether any documents will be produced in text-searchable format.

1       **9.     Class Actions**

2             The above-captioned cases are not class actions.

3       **10.    Related Cases**

4             This Court granted the parties' motion to relate the above-captioned cases on October 21,  
5 2014. (Doc. 212, No. 4:14-cv-3640-CW).

6             The related case of *Technology Properties Limited LLC, et al. v. Action Electronics Co.*,  
7 Case No. 4:14-cv-4616-DMR (N.D. Cal.) was recently transferred from the Eastern District of  
8 Texas to the Northern District of California. This case is currently before the Honorable Donna  
9 M. Ryu and is set for Initial Case Management Conference on January 1, 2015. (No. 4:14-cv-  
10 4616-DMR, Doc 93.) On November 12, 2014, Plaintiffs filed a Notice of Pendency of Other  
11 Action Involving Same Patents in this case and in Case No. 4:14-cv-4616-DMR.  
12

13       **11.    Relief**

14             **Plaintiffs' statement of relief sought:**

15             Plaintiff seeks the relief request in its prayers for relief in its complaints. In addition,  
16 Plaintiffs state that Title 35 of the United States Code, section 284 provides: "[u]pon finding for  
17 the claimant the court shall award the claimant damages adequate to compensate for the  
18 infringement, but in no event less than a reasonable royalty for use made of the invention by the  
19 infringer, together with interest and costs as fixed by the court." Plaintiffs intend to seek  
20 damages of at least a reasonable royalty pursuant to 35 U.S.C. § 154(d), adequate to compensate  
21 Plaintiff for Defendants' infringement. Plaintiffs intend to seek pre-judgment and post-judgment  
22 interest and costs as fixed by the Court.  
23  
24  
25  
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27  
28

1 The reasonable royalty analysis that Plaintiffs intend to pursue is governed by *Georgia-*  
 2 *Pac. Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970), *modified sub nom.*,  
 3 *Georgia-Pac. Corp. v. U.S. Plywood-Champion Papers, Inc.*, 446 F.2d 295 (2d Cir. 1971 and  
 4 cases developing therefrom). Such a computation of damages that Plaintiffs intend to seek  
 5 depends on a number of factors which are subject to ongoing fact and expert discovery.

6 Because a computation of damages depends on a number of factors which are subject to  
 7 ongoing fact and expert discovery, the complete computation cannot be provided at this time.

8 **Defendants' statement of relief sought:**

9 Defendants state that apart from the recovery of attorney fees and costs, they do not  
 10 currently anticipate claiming damages in this action. Defendants seek to recover their costs and  
 11 attorneys' fees in this action but cannot calculate those amounts at this time.

12 Defendants deny Plaintiffs' allegations of infringement and, therefore, contend that  
 13 Plaintiffs are not entitled to any damages in this action. Plaintiffs have not yet provided any  
 14 purported basis under which any damages should be calculated or the amount of any of damages  
 15 to which Plaintiffs allege they are entitled. However, should any asserted claim be found to be  
 16 both valid and infringed, Defendants contend that any damages should be calculated using a  
 17 reasonable royalty based upon the smallest salable unit.

18 **12. Settlement and ADR**

19 The parties believe that there are prospects for settlement.

20 Parties have submitted their statements of compliance with ADR L.R. 3-5.

21 The Court has scheduled an ADR Telephone Conference for all cases on November 14,  
 22 2014 at 1:00 pm (Pacific).

1 In all cases, the Court entered a November 3, 2014 Order for all parties, in all cases, to  
2 participate in a court-connected mediation within 90 days of the Order (February 1, 2015).

3 **13. Consent to Magistrate Judge For All Purposes**

4 All parties do not consent to have a magistrate judge conduct all further proceedings  
5 including trial and entry of judgment.  
6

7 **14. Other References**

8 The parties do not believe that these cases are suitable for reference to binding  
9 arbitration, a special master, or the Judicial Panel on Multidistrict Litigation.

10 **15. Narrowing of Issues**

11 **Plaintiffs' Proposal:**

12 **A. Early Claim Construction**

13 Plaintiffs believe that early claim construction on the "mapping" terms of the asserted  
14 claims of the Asserted Patents has the potential to immensely help narrow the issues early in the  
15 case and facilitate just, speedy, and inexpensive disposition of this matter.  
16

17 Defendants prevailed in the ITC investigation involving the Asserted Patents based on the  
18 Administrative Law Judge's decision on the "mapping" terms. The Administrative Law Judge  
19 set forth no other basis for his non-infringement determination on the Asserted Patents. The  
20 construction of the "mapping" terms is potentially dispositive. At the very least, the potential for  
21 early resolution of these cases increases after construction of the "mapping" terms.  
22

23 Thus, Plaintiffs respectfully request that the Court allow the parties to submit early claim  
24 construction briefing on the "mapping" terms and hold an early claim construction hearing on the  
25 "mapping terms."  
26



Plaintiffs' proposal for an early claim construction schedule is set forth below. Plaintiffs are also amendable to early claim construction on all terms.

<u>Event (Early Claim Construction on "Mapping" Terms)</u>	<u>Proposed Dates</u>
Exchange of proposed claim constructions and extrinsic evidence (L.P.R. 4-2)	November 25, 2014
Joint Claim Construction and Prehearing Statement (L.P.R. 4-2)	December 2, 2014
Completion of Claim Construction Discovery (L.P.R. 4-4)	December 9, 2014
Plaintiffs to file the Opening Claim Construction Brief	December 19, 2014
Defendants to file their Responsive Claim Construction Brief	January 7, 2015
Plaintiffs to file the Reply Claim Construction Brief	January 14, 2015
Claim Construction Hearing	January 28, 2015

#### **B. Stay of Deadlines Pending Early Claim Construction**

If the Court conducts early claim construction on the "mapping" terms or all terms, Plaintiffs are amenable to staying all deadlines, except for deadlines related to mediation and early settlement conferences, until the Court issues a claim construction order. This would eliminate a situation where the parties would expend additional resources on litigating these cases, only to have the Court issue an early claim construction ruling on terms that are potentially dispositive.

#### **C. Representative Products**

Plaintiff believes that issues in this case can be narrowed if Defendants will agree to use representative products for purposes of determining infringement. There are numerous accused products in the above-captioned actions that—for purposes of infringement—function and are

1 designed in substantially the same way. For example, there are over one thousand (1000)  
2 accused products for HP and over two-hundred and fifty (250) accused products for Canon.  
3 These numbers may increase after Plaintiffs have an opportunity to take discovery on additional  
4 products that Plaintiffs have not yet discovered.

5 Accordingly, an agreement for representative products for each Defendant will eliminate  
6 the need for the parties to incur time and expense of a) serving discovery on the technical details  
7 of numerous products, b) providing discovery on the technical details of numerous products, c)  
8 making deponents available for depositions on topics related to the technical details of numerous  
9 products, d) having experts submit expert reports on numerous products, e) submitting  
10 dispositive motions related to the technical details of numerous products, and f) spending  
11 unnecessary time presenting evidence on the technical details of numerous products to a jury.  
12

13  
14 **D. Production of Documents in the Parties' Control**

15 Plaintiffs believe that the parties should agree that they will produce relevant documents  
16 (including technical documents related to the accused products) that are in the parties' control.  
17 For example, to the extent that Defendants' equipment manufacturers have technical documents  
18 regarding the accused products, or components thereof, in their possession, but still in  
19 Defendants' control, Plaintiffs believe that Defendants should have to produce these documents.  
20 This will reduce the time and resources devoted to discovery for all parties and eliminate the  
21 need for third parties, including many foreign entities, to be burdened by subpoenas for  
22 documents and/or deposition.  
23

24 **Defendants' Proposal:**

25 **A. Claim Construction**

Defendants do not agree with Plaintiffs' proposal for piecemeal claim construction. Defendants instead propose to proceed as contemplated by this Court's Case Management Order and the Local Patent Rules, and to decide issues of claim construction in conjunction with dispositive motions, as set forth below:

DATE	EVENT
11/19/14	Initial Case Management Conference
12/3/14	Local P.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions and P.R. 3-2 Document Production
1/16/15	Local P.R. 3-3 Invalidity Contentions and P.R. 3-4 Document Production
1/30/15	Local P.R. 4-1(a) Exchange of Proposed Terms for Construction
2/20/15	Local P.R. 4-2(a)-(b) Simultaneous Exchange of Proposed Constructions and Identification of Intrinsic/Extrinsic Evidence
3/18/15	Local P.R. 4-3 File Joint Claim Construction and Prehearing Statement
5/22/15	Completion Claim Construction Discovery and Fact Discovery (not relating to damages) (Local P.R. 4-4 )
5/29/15	Disclosure of opening expert witnesses and reports on issues for which party bears the burden (not relating to damages)
6/19/15	Disclosure of rebuttal expert witnesses and reports on issues for which opposing party bears the burden (not relating to damages)
7/17/15	Completion of expert discovery (not relating to damages)
7/31/15	Plaintiffs' Opening Claim Construction and Summary Judgment Brief (Local P.R. 4-5(a))
8/21/15	Defendants' Claim Construction Brief / Opposition and Cross Motion for Summary Judgment (Local P.R. 4-5(b))
9/4/15	Plaintiffs' Reply/Opposition to Cross Motion (Local P.R. 4-5(c))

9/18/15	Defendants' Reply to Cross Motion
9/25/15	Tutorial/Claim Construction/Summary Judgment Hearing (Subject to Court Availability) (Local P.R. 4-6)

**B. Stay of Deadlines**

Defendants are amenable to staying discovery relating to damages pending the resolution of claim construction and dispositive motions. Accordingly, Defendants' proposed schedule does not contemplate damages discovery, if necessary, until after resolution of the claim construction and summary judgment issues.

**C. Representative Products**

Plaintiffs' proposal regarding an agreement on representative products is premature at this time because Plaintiffs have not yet put forth sufficient infringement contentions on the accused products. *Bender v. Maxim Integrated Prods.*, 2010 U.S. Dist. LEXIS 32115, \*7-8 (N.D. Cal. March 22, 2010 ). Plaintiffs' proposal relates to only the "mapping" limitation of the asserted claims, and ignores any differences among the accused products relating to other claim limitations. Pursuant to Local P. R. 3-1(c), Plaintiffs must provide "[a] chart identifying specifically where *each limitation* of each asserted claim is found within each Accused Instrumentality..." (emphasis added). Defendants cannot agree to representative products until Plaintiffs meet their obligations under that rule, which will allow Defendants to consider whether a proposal regarding representative products is well-founded.

**D. Document Production**

Defendants will produce responsive documents in their possession, custody or control as required by the Federal Rules of Civil Procedure. To the extent that Plaintiffs' proposal above

purports to extend or enlarge Defendants' obligations under the rules, including by purporting to require Defendants to produce documents in the possession of third parties, Defendants oppose it.

**16. Expedited Trial Procedure**

While the parties believe that the issues in this case can be narrowed, the parties do not believe that this is the type of case that can be handled under the Expedited Trial Procedure of General Order No. 64 Attachment A.

**17. Scheduling**

**Plaintiffs' Proposal:**

The parties agree to meet and confer on a schedule within seven (7) days of the Court's initial claim construction order.

**Defendants' Proposal:**

Defendants propose a schedule consistent with the Local Patent Rules and the Court's Case Management Order, and to decide issues of claim construction in conjunction with dispositive motions, as set forth in Defendants' proposal in Paragraph 15 above.

**18. Trial**

A jury trial has been requested. The parties expect the length of trial to be five (5) days per Defendant.

**19. Disclosure of Non-party Interested Entities or Persons**

Plaintiffs will file their Certifications of Interested Entities or Persons pursuant Civil Local Rules 3-15 once Plaintiffs' counsel enter their appearances.

1 Seiko Epson Corp. and Epson America, Inc. filed their Certifications of Interested  
2 Entities or Persons pursuant Civil Local Rules 3-15 on October 29, 2014, and stated that U.S.  
3 Epson, Inc. owns 100% of defendant Epson America, Inc. and is 100% owned by defendant  
4 Seiko Epson Corporation.

5 Canon Inc. and Canon U.S.A., Inc. filed their Certifications of Interested Entities or  
6 Persons pursuant to Civil Local Rule 3-15 on October 29, 2014, and stated that Canon Inc., a  
7 publicly-held corporation that trades on the Tokyo Stock Exchange, is the parent of Canon  
8 U.S.A., Inc., and that no public entity owns more than 10% of either Canon Inc.'s or Canon  
9 U.S.A., Inc.'s stock.  
10

11 Hewlett-Packard Company filed its Certification of Interested Entities or Persons  
12 pursuant to Civil Local Rule 3-15 on October 29, 2014, and stated that there is no such interest to  
13 report.  
14

15 HiTi Digital America Inc. filed its Certification of Interested Entities or Persons pursuant  
16 to Civil Local Rule 3-15 on October 29, 2014, and stated that HiTi Digital America Inc. is a  
17 wholly owned subsidiary of HiTi Digital Inc.  
18

19 Kingston Technology Co., Inc. filed its Certification of Interested Entities or Persons  
20 pursuant to Civil Local Rule 3-15 on October 29, 2014, and stated that there is no such interest to  
21 report.  
22

23 Newegg Inc. and Rosewill Inc. filed their Certification of Interested Entities or Persons  
24 pursuant to Civil Local Rule 3-15 on October 28, 2014 (corrected on October 30, 2014),  
25 identifying certain potential indemnitors.  
26

Falcon Northwest Computer Systems, Inc. filed its Certification of Interested Entities or Persons pursuant to Civil Local Rule 3-15 on October 28, 2014, and stated that there is no such interest to report.

**20. Professional Conduct**

All attorneys of record for the parties have reviewed the Guidelines for Professional Conduct for the Northern District of California.

**21. Other**

See Section 15 (Narrowing of the Issues) for Plaintiffs' proposal to narrow the issues in these cases, which would help facilitate just, speedy, and inexpensive resolution of these matters.

As set forth above, Defendants disagree with Plaintiffs' proposal regarding a piecemeal claim construction, as such a procedure would result in an inefficient use of party and judicial resources and would not facilitate just, speedy, or inexpensive resolution of these matters. Defendants propose that the case should proceed pursuant to the Local Patent Rules and this Court's Case Management Order, and Plaintiffs should be required to provide sufficient infringement contentions. Defendants propose that all claim construction issues be dealt with at once in connection with dispositive motions.

Dated: November 13, 2014

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Page 24 of 28

C14-03640-CW, C14-03641-CW, C 14-03642-CW,  
C 14-03643-CW, C 14-03644-CW, C 14-03645-CW,  
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Page 25 of 28

C14-03640-CW, C14-03641-CW, C 14-03642-CW,  
C 14-03643-CW, C 14-03644-CW, C 14-03645-CW,  
C 14-03646-CW, C 14-03647-CW

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Page 26 of 28

C14-03640-CW, C14-03641-CW, C 14-03642-CW,  
C 14-03643-CW, C 14-03644-CW, C 14-03645-CW,  
C 14-03646-CW, C 14-03647-CW

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26  
27 Page 27 of 28

28 C14-03640-CW, C14-03641-CW, C 14-03642-CW,  
C 14-03643-CW, C 14-03644-CW, C 14-03645-CW,  
C 14-03646-CW, C 14-03647-CW

**CASE MANAGEMENT ORDER**

The above JOINT CASE MANAGEMENT STATEMENT & PROPOSED ORDER is approved as the Case Management Order for this case and all parties shall comply with its provisions. [In addition, the Court makes the further orders stated below:]

IT IS SO ORDERED.

Dated:

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UNITED STATES DISTRICT/MAGISTRATE JUDGE